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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,483	03/25/2004	Hironori Osuga	033036M073	5757
441 7590 11/06/2007 SMITH, GAMBRELL & RUSSELL 1130 CONNECTICUT AVENUE, N.W., SUITE 1130 WASHINGTON, DC 20036			EXAMINER SELLERS, ROBERT E	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 11/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,483

Applicant(s)

OSUGA, HIRONORI

Examiner

Robert Sellers

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08).
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is responsive to the Request for Continued Examination and amendment filed September 14, 2007.

Claims 4 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on May 2, 2006.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed August 22, 2006.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichiroku et al. Patent No. 6,506,822 in view of Shiobara et al. Patent No. 6,310,120 and Shintai et al. Patent No. 5,362,775.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed September 14, 2007 have been considered but are unpersuasive.

Ichiroku et al. discloses from 0.1 to 20 parts by weight of finely divided silica having a specific surface area of preferably from 100 to 400 m²/g (col. 7, lines 2-5) embracing the claimed ranges of from 120-240 m²/g in claim 1 (supported by the specification on page 15, Table 2, Example 4), and from 180-240 m²/g in new claim 8 (supported by Example 2 of Table 1).

The examples in column 2, lines 10-11 and 21-23 show specific surface areas of 200 m²/g (Oil Compound i-1) and 300 m²/g (Oil Compound i-2), respectively.

The comparison between Example 2 (180 m²/g of ultrafine silica) and Example 4 (240 m²/g) versus Comparative Examples 3 (100 m²/g) and (340 m²/g) is unpersuasive because the closest prior art specific surface areas of 200 m²/g within the claimed ranges and 300 m²/g have not been tested. The claims do not preclude the treatment of the 200 m²/g finely divided silica with a (CH₃)₃SiNHSi(CH₃)₃ surface hydrophobizing agent in Oil Compound i-1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers
Primary Examiner
Division 1796